REMARKS

Claims 1 – 7, 9 – 18 and 20 - 27 are pending in this application.

Applicant, applicant's representation Dexter Chang, Reg. No. 44,071, and the Examiner conducted a telephone interview on July 29, 2005. Applicant and Mr. Chang thank the Examiner for his time in participating in this interview.

35 U.S.C. § 132(a) Objection to the Specification

The Examiner objected to the amendments to the specification in applicant's January 18, 2005 response under 35 U.S.C. § 132(a) for allegedly introducing new matter. Applicant respectfully traverses the Examiner's objection.

The Examiner objected to applicants correction of Figs. 4a-4d and their corresponding description on pages 12-15 of the specification. Specifically, the Examiner asserted that "a list of operators [being] updated after a selection of an initial item entry" is new matter not supported by the original disclosure, and that the original disclosure only supported "updating the list of operators after a second term is selected, wherein the second item is selected after the initial item and an operator are selected." Page 2, lines 12-13 of the Office Action.

> An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction. *In re Odu*, 443 F 2d 1200, 170 USPQ 268 (CCPA 1971).

The Examiner has acknowledged that the original disclosure provides for "updating" the list of operators in response to a user's selection. Applicant respectfully submits that one skilled in the art would ascertain that "updating" a user's choices, including a list of operators, in response to a user's selection of an entry item is adequately described in the original disclosure—see, e.g., Fig. 6 and the corresponding description of the specification—such that it would be inconsistent not to update the list of operators after a user selects an item. Applicant

realized that the illustrative embodiment described in Figs. 4a-4d contained an inconsistency in

demonstrating this feature of the claimed invention and amended the specification and figures in

a good faith effort to clarify the claimed invention. It is respectfully submitted that one skilled in

the art would recognize this inconsistency and the appropriate correction made by the applicant

in the above January 18, 2005 Response.

M.P.E.P. 2163.07(a) Inherent Function, Theory, or Advantage

"By disclosing in a patent application a device that inherently performs a function or has a
property, operates according to a theory or has an advantage, a patent application necessarily
discloses that function, theory or advantage, even though it says nothing explicit concerning it.
The application may later be amended to recite the function, theory or advantage without

In fact, the Examiner, in his § 103 prior art rejection discussed below, cited U.S. Patent

No. 5,963,938 to <u>Wilson et al.</u> as describing "updating (logical) operators to limited possible

operators based on a selected (initial) attribute or (initial) entry." Page 5, lines 7-8 of the Office

Action. Hence, the Examiner has explicitly acknowledged that updating logical operators based

on an initial entry is known to the skilled artisan. It would be inconsistent and facetious to assert

this feature to be available to the skilled artisan in a prior art rejection, but concurrently

unavailable to the same skilled artisan when reading the original disclosure that clearly describes

updating a list of operators in response to a user entry.

In view of the above remarks, applicant respectfully requests that the Examiner withdraw

the §132(a) objection to the specification.

<u>35 U.S.C. §112 Rejection</u>

Claims 1-7, 9-18, and 20-27 stand rejected under the second paragraph of 35 U.S.C. §

112, first paragraph, as failing to comply with the enablement requirement. Specifically, the

Examiner found that the claimed feature of "updating the list of operators after the initial item

entry is selected" was not described in the specification in such a way to enable one skilled in the

art to make and/or use the invention. Applicant respectfully traverses the rejection.

M.P.E.P. 2164.01(b) How to Make the Claimed Invention
"As long as the specification discloses at least one method for making and using the claimed
invention that bears a <u>reasonable correlation</u> to the entire scope of the claim, then the enablement
requirement of 35 U.S.C. 112 is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24
(CCPA 1970) Failure to disclose other methods by which the claimed invention may be made
does not render a claim invalid under 35 U.S.C. 112. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827
F.2d 1524, 1533, 3 USPQ2d 1737, 1743 (Fed. Cir.), *cert. denied*, 484 U.S. 954 (1987)... A key
issue that can arise when determining whether the specification is enabling is whether the starting
materials or apparatus necessary to make the invention are available." (Emphasis added)

As discussed above, "updating" the list of operators after an item entry is adequately

described in the original disclosure. The "updating" of the list of operators after a second item

operates under the same general principle, and is, therefore, reasonably correlated to an

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"updating" after an initial item. As such, one skilled in the art would be able to make and use the invention, including "updating" the list of operators after a user's initial item entry, by reading the original disclosure.

M.P.E.P. 2164.02 Working Example

"The presence of only one working example should never be the sole reason for rejecting claims as being broader than the enabling disclosure, even though it is a factor to be considered along with all the other factors. To make a valid rejection, one must evaluate all the facts and evidence and state why one would not expect to be able to extrapolate that one example across the entire scope of the claims."

Applicant respectfully submits that one skilled in the art would be able to extrapolate from the working examples described in the original disclosure to include "updating" the list of operators after an initial item.

In fact, the Examiner, in his § 103 prior art rejection discussed below, cited U.S. Patent No. 5,963,938 to Wilson et al. as describing "updating (logical) operators to limited possible operators based on a selected (initial) attribute or (initial) entry." Page 5, lines 7-8 of the Office Action. Hence, the Examiner has explicitly acknowledged that updating logical operators based on an initial entry is known to the skilled artisan. It would be inconsistent and facetious to assert this feature to be available to the skilled artisan in a prior art rejection, but concurrently unavailable to the same skilled artisan in an enablement rejection.

In view of the above remarks, applicant respectfully requests that the Examiner withdraw this rejection.

35 U.S.C. § 103 Rejection

Claims 1-7, 9, 11 - 18 and 20-27 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,374,275 to Wasilewski in view of "A unified approach to automatic indexing and information retrieval" by Ginsberg, Wilson et al., and U.S. Patent 6,006,225 to Bowman et al. Claim 10 is rejected under 35 U.S.C. §103(a) as being unpatentable

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over <u>Wasilewski</u> in view of <u>Ginsberg, Wilson et al., Bowman et al.</u> and U.S. Patent 5,995,982 to

<u>Carey et al.</u> Applicant respectfully traverses these rejections.

Independent claim 1 recites:

"1. A method for displaying the progress and results of a database search until a
desired result is displayed, said method comprising the steps of:

a. <u>displaying a set of entries</u> from a database and a set of operators, wherein ones
of said displayed set of entries and ones of said displayed set of operators may be
selected to form a database search query for producing valid results

b. selecting an initial entry of said displayed set of entries;

c. displaying a set of valid results from a query based on said selected entry;

d. updating said set of displayed operators based on said selected entry, wherein
said updated set of displayed operators includes only those operators from the set
of operators that may be combined in a query with the selected entry and at least
one of the set of entries from the database to produce at least one valid result;

e. selecting an operator from the updated displayed set of operators;

f <u>updating said displayed set of entries</u> in response to the selected operator,
wherein said updated displayed set of entries includes only those entries from the
database that may be combined in a query with the selected entry and the selected
operator to produce at least one valid result;

g. selecting one of said updated displayed set of entries;

h. updating said displayed set of valid results according to a query based on the
selected entries and the selected operator; and

i. while said displayed set of valid results is not the desired result, repeating steps
d. through h., based on all previously selected entries and operators, to select an
additional operator and an additional entry for the database search query, and to
update said displayed set of valid results." (Emphasis added)

Applicant respectfully submits that all of the cited art, and in particular the <u>Wasilewski,</u>

<u>Ginsberg, Wilson et al.</u> and <u>Bowman et al.</u> references, individually and in combination, fail to

teach or suggest the claimed invention.

<u>Wasilewski</u> discloses a pick-list generator for a keyboardless environment that is driven

by context-sensitive pop-up displays (see, e.g., column 2, lines 9 – 51 of <u>Wasilewski</u>). The

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Examiner suggests that Wasilewski discloses applicant's claimed limitation relating to the display of entries, operators and results, but acknowledges that Wasilewski fails to disclose applicant's claim limitations relating to the updating of a displayed result based on the selection of an entry.

Ginsberg discloses a graphical user interface that displays and updates a result based on a query entry (see, e.g., Fig. 1 on page 47 of Ginsberg). Applicant respectfully submits that Ginsberg, as applied by the Examiner, appears to merely describe navigating up and down a topic/subtopic tree in response to a keyword entry by a user. It, therefore, fails to disclose or suggest "displaying a set of entries...[and] updating said displayed set of entries in response to the selected operator," as recited in claim 1, whereby the original displayed list of entries available to the user for selection is updated in response to each of the user's selections. The Examiner further acknowledges that Ginsberg and Wasilewski fail alone and in combination disclose applicant's claim limitations relating to updating a displayed set of operators based on a selected entry

The Examiner suggests that Wilson et al. discloses "displaying operators and operands and updating (logical) operators to limited possible operators based on a selected attribute or entry" (with reference to Figs. 3, 9 and 12, column 2, lines 15 – 20, column 5, lines 58 - 62, column 7, lines 2 – 6, column 10, lines 8 – 15 and column 18, lines 31 – 36 of Wilson et al.). Applicant respectfully submits, however, that Wilson et al. fails to disclose or suggest the operator updating limitations as specifically claimed by applicant.

Wilson et al. discloses an automatic context-organizing query interface including a dialog box that presents inter alia selectable field names, selectable field entries and selectable logical operators for creating a query (see, e.g., abstract and Fig. 12 of Wilson et al.). Wilson et al.

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discloses that the logical operators may be limited based on selection of a particular field or field

type (see, e.g., column 10, lines 8 – 15 and column 18, lines 31 – 36 of Wilson et al.). For

example, Wilson et al. suggests that the types of logical operators appropriately used with a field

type of "text" may differ widely from the types of logical operators appropriately used with a

field type of "accounting numbers".

Thus, Wilson et al., as relied upon by the Examiner, fails to disclose or suggest operators

being updated on the basis of a selected entry (i.e., a field value rather than a field or field type),

and on the basis of the added condition that each operator on the updated operator list can be

combined with the selected entry and an additional entry in the entry list to produce an updated

result. Thus, Wilson et al., as relied upon by the Examiner, does not teach or suggest

> "updating said set of displayed operators based on said selected entry, wherein said
> updated set of displayed operators includes only those operators from the set of operators
> that may be combined in a query with the selected entry and at least one of the set of
> entries from the database to produce at least one valid result," as recited in claim 1.
> (Emphasis added)

Applicant respectfully submits that Ginsberg, Wasilewski and Wilson et al., alone or in

combination, fail to disclose or suggest these limitations of applicant's claimed step for updating

the operator list.

The Examiner further acknowledges that the combination of Ginsberg, Wasilewski and

Wilson et al. fails to disclose applicant's claim limitations relating to updating the displayed set

of entries, but suggest that Bowman et al. discloses a method for "eliminating inappropriate

items" (with reference to column 2, line 28 through column 3, line 30, column 4, lines 32 – 35,

column 9, lines 42 – 45 and column 12, lines 42 – 67 of Bowman et al.).

Bowman et al. discloses a search engine that suggests additional search terms based on

previously selected terms (see, e.g., abstract of Bowman et al.). Bowman et al.'s method operates

by maintaining a <u>correlation table</u> that indicates the <u>frequency with which specific terms have</u> <u>appeared together in previous queries</u>, thereby reducing the chance of yielding a null result. (see, e.g. col. 3, lines 6-25 of <u>Bowman et al.</u>)

As such, <u>Bowman et al.</u>, as relied upon by the Examiner, fails to teach or suggest

"<u>displaying a set of entries</u>. [and] <u>updating said displayed set of entries in response to the</u> <u>selected operator</u>, wherein said updated displayed set of entries includes only those entries from the database that may be combined in a query with the selected entry and the selected operator to produce at least one valid result..."

Applicant respectfully submits that <u>Ginsberg, Wasilewski, Wilson et al.</u> and <u>Bowman et</u> <u>al.</u>, alone or in combination, fail to disclose or suggest these limitations of applicant's claimed step for updating the entry list.

Accordingly, applicant submits that, for at least the above-cited reasons, applicant's independent claim 1 is not made obvious by the cited references. Applicant substantially repeats these arguments to submit that amended independent claims 18, 22, 26, and 27, which disclose limitations that are analogous to the cited limitations of claim 1, are also nonobvious in view of the cited references. Accordingly, applicant submits that amended independent claims 1, 18, 22, 26, and 27 are allowable. As claims 2 – 7, 9 – 17, 20, 21 and 23 – 25 each depend from one of allowable claims 1, 18, and 22, applicant further submits that claims 2 – 7, 9 – 17, 20, 21 and 23 – 25 are also allowable for at least this reason.
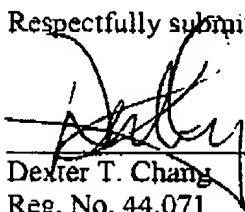
CONCLUSION

An earnest effort has been made to be fully responsive to the Examiner's objections. In view of the above amendments and remarks, it is believed that claims 1 – 7, 9 – 18 and 20 - 27, consisting of independent claims 1, 18, 22, 26 and 27 and the claims dependent therefrom, are in condition for allowance. Passage of this case to allowance is earnestly solicited. However, if for any reason the Examiner should consider this application not to be in condition for allowance,

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the Examiner is respectfully requested to telephone the undersigned attorney at the number listed

below prior to issuing a further Action.

Any fee due with this paper may be charged on Deposit Account 50-1290.

Respectfully submitted,

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